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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,294	09/11/2003	Milton Davila	68876	5437

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SCOTT C. RAND, ESQ.
MCLANE, GRAF, RAULERSON & MIDDLETON, PA
900 ELM STREET, P.O. BOX 326
MANCHESTER, NH 03105-0326

EXAMINER

TRAIL, ALLYSON NEEL

ART UNIT PAPER NUMBER

2876

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/660,294

Applicant(s)

DAVILA ET AL.

Examiner

Allyson N Trail

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-47 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 9-47 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/10/2003</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Preliminary Amendment

1. Receipt is acknowledged of the Amendment filed December 05, 2003.

Specification

2. The disclosure is objected to because of the following informalities:

Please list the parent data under the heading "CROSS-REFERENCE TO RELATED APPLICATIONS", i.e., application number 10/056739, now patent number 6,666,378.

Appropriate correction is required.

Double Patenting

3. Claims 9-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,666,378 hereinafter '378. Claims 9-12 recite the same greeting card assembly as set forth in claim 1 of '378.

The applicant's claim a greeting card assembly comprising a greeting card body having greeting indicia inscribed thereon; a first opening formed in the card body; a computer readable storage medium received in the first opening; a second opening formed in the card body; and a gift card received in the second opening. The computer readable storage medium is further disclosed to comprise an audio compact disc. It is also further disclosed in claims 11 and 12 of the current invention, that the gift card is a gift certificate.

The only difference between the present claimed invention and of 'the '378 patent is the utilization of different terminologies and/or rephrasing of the terminologies. The Examiner believes that the scope of claims 9-12 of the present application, and claim 1 of the '378 patent are almost identical but differ only in terminology and/or phrasing of terminology. Thus, with respect to above discussions, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to utilize the teachings of claim 1 of the '378 patent and modify the terminology and the phrasing of the claims.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.32(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d)

Claim Objections

4. Claims 18 and 19 are objected to because of the following informalities:

Re claim 18, line 2: replace "the first surface" with --the first face--.

Re claim 19, lines 2 and 3: replace "the first surface" with --the first face--.

"Surface" is not disclosed in claim 13. The panels are described as having first and second faces, not surfaces.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 9-17, 20, 21, 24, 27, 28, 31, 33-40, 45, and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Dawson (5,761,836).

Dawson teaches the following in regards to claim 9:

Figure 1 is a plan view of an opened out, two-leaved greeting card.

"The card may be a flat card such as a postcard or may have two or more leaves which fold together. The card itself, together with the musical or vocal message it contains, is appropriately designed and selected to mark a given occasion." (Col. 2, lines 10-14).

Figure 1 shows a first opening 3a and a second opening 4a.

The openings may contain the following: "a lottery scratch card, ticket, photograph, compact disc, bank note, cheque, or the like." (Col. 2, lines 2-5).

Dawson teaches the following in regards to claim 10:

The computer readable storage medium as disclosed above comprises an audio compact disc. (Col. 2, lines 2-5).

Dawson teaches the following in regards to claims 11 and 12:

The gift card as disclosed above may comprise a gift certificate, a coupon, or a pre-paid phone card. (Col. 2, lines 2-5).

See column 2, lines 6-9 as well, "Alternatively, the article may be any item which is generally delivered to its recipient attached to a letter, card, or the like, for example a credit card, bank card or a personal identification card."

Dawson teaches the following in regards to claim 13:

See figure 1. The greeting card body comprises a generally flat outer panel having a first and second face. The outer leaf 1a is defined as the outer panel. The first face is shown. The second face (not shown) is on the other side of the first face. The card body further comprises an inner panel having a first and second face. The inner leaf 1b is defined as the inner panel. The first face is shown. The second face (not shown) is on the other side of the first face. The first face of the outer panel (upper leaf) is disposed in aligned, facing relation to the first face of the inner panel. A first slot 3a is formed in the inner panel and receives the CD, whereby a portion of the CD is retained between the first face of the inner panel and the first face of the outer panel.

Dawson teaches the following in regards to claims 14 and 15:

The gift card as disclosed above may comprise a gift certificate, a coupon, or a pre-paid phone card. (Col. 2, lines 2-5).

Dawson teaches the following in regards to claim 16:

See figure 1. The gift items are fastened with a slot, 3a.

Dawson teaches the following in regards to claims 17, 20, 21, and 24:

Figure 1 shows a fold line 2, which connects the outer panel with the inner panel. The fold line 2 creates a top bi-folding greeting card. The figure also shows the card to be rectangular.

Dawson teaches the following in regards to claims 27 and 28:

The openings may contain the following: "a lottery scratch card, ticket, photograph, compact disc, bank note, cheque, or the like." (Col. 2, lines 2-5).

Dawson teaches the following in regards to claim 31:

"Additionally, the term "card" should be understood to include any suitable materials, including stiff and flexible materials whether fabricated from paper, cardboard, plastics material, metal or otherwise." (Col. 2, lines 16-20).

Dawson teaches the following in regards to claims 33 and 34:

Figure 1 shows additional slots 4a and 5a. The additional slots are used for additional gifts to be secured to the card.

Dawson teaches the following in regards to claim 35:

The gift card as disclosed above may comprise a gift certificate, a coupon, or a pre-paid phone card. (Col. 2, lines 2-5).

Dawson teaches the following in regards to claims 36 and 37:

Similar to the first slot, the second slot is also formed on the inner panel and attached via a fold line to the outer panel.

Dawson teaches the following in regards to claim 38:

Figure 1 shows a fold line 2 in which the card is folded.

Dawson teaches the following in regards to claims 39, 40, and 45:

As can be seen in figure 1, the first and second slots are both formed on the same side of the fold line. It is also shown that the card is a bi-fold greeting card.

Dawson teaches the following in regards to claim 46:

The openings may contain the following: "a lottery scratch card, ticket, photograph, compact disc, bank note, cheque, or the like." (Col. 2, lines 2-5).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 25, 26, 29, 30, 32, 41-43, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dawson (5,761,836).

Dawson's teachings are discussed above. Dawson fails to specifically teach various ways of folding the greeting card. These ways include side folding bi-fold, top folding tri-fold. Dawson also fails to specifically teach having the computer readable storage medium having a digital representation bearing a thematic relationship to the greeting card indicia. Dawson further fails to specifically teach including an envelope adapted to receive the greeting card. Lastly, Dawson fails to specifically teach forming the first and second slot on opposite sides of the fold line.

In addition to Dawson's teachings above, Dawson teaches the following in regards to claims 25, 26, and 42:

"The card may be a flat card such as a postcard or may have two or more leaves which fold together." (Col. 2, lines 11-12).

In view of Dawson's further teachings above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to fold the greeting card in

numerous configurations with more than one fold line and folding sideways. Although in figure 1 only one fold line is shown, Dawson teaches that the greeting card may include more than two leaves folded together. It is clear from the teachings, that various configurations of folding are suggested by Dawson.

Dawson teaches the following in regards to claims 29 and 30:

The greeting card includes an audio message or song. "The card itself, together with the musical or vocal message it contains, is appropriately designed and selected to mark a given occasion." (Col. 2, lines 12-14).

"For example, the card may be a Christmas or birthday card and carry a tune complementary to that occasion. Other examples of occasions which can be marked with such cards are: St. Valentines' day, New Years' day or other national holiday, wedding day, birth of a baby, anniversary day, sporting occasion, "get well" wish, holiday greeting". (Col. 2, lines 21-34).

In view of Dawson's further teachings above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the computer readable storage medium include a digital representation bearing a thematic relationship to the greeting card indicia. Dawson's teachings include an audio message having to do with the occasion for which the greeting card is presented. Dawson further teaches including a CD as part of the greeting card. It is therefore suggested by Dawson that the CD also include a thematic relationship to the greeting card.

Dawson teaches the following in regards to claims 32 and 47:

"Alternatively, the article may be any item which is generally delivered to its recipient attached to a letter, card or the like, for example a credit card, a bank card or a personal identification card." (Col. 2, lines 6-9).

In view of Dawson's further teachings above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include an envelope adapted to receive the greeting card. Dawson's teachings include presenting the greeting card with a letter or a card, both of which are received in the mail and therefore require an envelope. It is therefore suggested by Dawson that the greeting card include an envelope.

Dawson teaches the following in regards to claims 41 and 43:

"Any desired number of slot pairs may be provided." (Col. 2, line 61).

"Additionally, the article held on the card need not be a gift item but may equally be some other article to be delivered to a recipient, for example, a credit card." (Col. 3, lines 56-58).

In view of Dawson's further teachings above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the first and second slot be formed on opposite sides of the fold line and further to have a credit card with a magnetic strip extend beyond a peripheral edge of the greeting card body so that the strip is accessible when the greeting card body is in a closed position. Dawson's teachings disclose that a number of slot pairs may be provided and that a credit card may be secured in one of the slots. Dawson also teaches including more than two leaves used to form the card. It is therefore suggested by Dawson that the greeting

card include slots located on opposite sides of the fold line and additionally, that the credit card be set in one of the slots so that the magnetic strip is accessible when the greeting card is closed.

9. Claims 18, 19, 22, 23, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dawson (5,761,836) in view of Bradley (5,946,834).

Dawson's teachings are discussed above. Dawson fails to specifically teach using glue to secure the first surface of the inner panel to the first surface of the outer panel. Dawson further fails to teach forming the card body via die cutting.

Bradley teaches the following in regards to claims 18, 19, 22, 23, and 44:

"In accordance with another aspect of the invention, a method of automatically producing three dimensional greeting cards includes the steps of printing a greeting card image on greeting card stock, cutting greeting cards from the greeting card stock by an automatic die cutting machine, applying glue to at least one area of the greeting card stock by an automated glue applying apparatus, folding the printed greeting card stock in an automated folding machine whereby the applied glue adheres at least two panels of the card in a folded configuration." (Col. 1, lines 46-55).

In view of Bradley's teachings it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Bradley's method of cutting the greeting cards and gluing different panels together. Although not specifically taught by Dawson, it would have been obvious to use Bradley's method of die-cutting the greeting cards. Die-cutting is a method used to precisely cut or separate different materials.

One would be motivated to use the die-cut method to form the slots in order to

accurately form the slots in the correct location on the greeting card. Using glue to secure the first surface of the inner panel to the first surface of the outer panel is also an obvious method of keeping two materials together. One would be motivated to secure the two panels together in order to ensure that the gifts inside the card do not fall out. Glue is inexpensive and therefore one would want to use it as the adhesive securing the two panels together.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Cox et al (2003/0028439), Ivey (4,765,466), Wong (5,282,437), Crowell (5,387,108), Miska (6,449,891), Reinig (2001/0047843), Hollingsworth et al (2002/0100797), Pollock (6,070,719), Johnson (5,595,008), Fonseca (5,629,977), and McKenzie (2003/0052021).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Allyson N. Trail* whose telephone number is (571) 272-2406. The examiner can normally be reached between the hours of 7:30AM to 4:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571) 272-2398. The fax phone number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [allyson.trail@uspto.gov].

All Internet e-mail communications will be made of record in the application file.

PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Allyson N. Trail
Patent Examiner
Art Unit 2876
May 5, 2004

Jared J. Fureman
JARED J. FUREMAN
PRIMARY EXAMINER